

REMARKS

In the Office Action mailed December 9, 2004, the Examiner rejected claims 1-4, 6-25 and 27-31. By way of the foregoing amendments and the markings to show changes Applicants have amended claims 1-4, 22 and 23 and added new claim 32. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Rejections under 35 USC 102/103

The Office Action rejected claims 1-4, 6-25 and 27-31 as obvious in view of two or more of the following references: Locke et al. (US 6,291,019); Burton (US 5,925,466); Wade et al. (US 5,580,945); Meader, Jr. et al. (US 4,025,683); Uhran et al. (US 4,145,512); Thomaides et al. (US 5,626,840); Primeaux et al. (US 5,731,397); Wayne (US 4,341,412).

Claim 1

Claim 1 has been amended to include the language "wherein the amount of the at least one secondary amine is between about 40% and about 80% by volume of the second component and the at least one primary amine is between about 10% and about 40% of the second component".

The Office Action contends that such amounts of Locke et al. are "within the applicant's claimed range" and reference col. 10, lines 28-50 of Locke et al. The Office Action then suggests, as if admitting that Locke et al. does not really disclose applicant's claimed range, that, "It would have been obvious and within the skill of one practicing in the art, through routine experimentation, to optimize the performance properties of the resulting coating by determining the relative amounts of the components in the mixture...absence evidence of unexpected results."

Applicants assert that this contention lacks merit, particularly since Locke et al does not provide any suggestion, guidance or motivation to provide the amounts claimed by applicants. At best, Locke et al. at col. 10, lines 28-50, merely suggests the possibility of using "primary and second amine-terminated polyethers..." Locke et al. appears to provide no suggestion that relative amounts of primary and

secondary amine can provide any advantage. As such, the skilled artisan would not be motivated to provide Applicants' claimed ranges in view of Locke et al. or even to experiment with ranges such as those recited. Moreover, the present application reads that, "the amine component may be provided as a mixture of primary and secondary amines that are combined according to weight ratios that are chosen as desired to control the rates of curing of the composition to form the coating." As such, Applicants disclose at least one advantage of their relative amounts of primary and secondary amines. Thus, Applicants contend that claim 1 is patentable over the references of record.

Applicants point out that the language added to claim 1 was already pending in previous claim 23, which was ultimately dependent upon claim 1. As such, Applicants further point out that it would likely be improper to present a final rejection of claim 1 on a grounds alternative to that already presented since applicants have not amended claim 1 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor base on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor base on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

Claims 4, 22 and 23 dependent upon claim 1

Applicant further draw attention to claims 4, 22 and 23 which are dependent upon claim 1.

Claim 4 now recites, "wherein the isocyanate component is present in the composition from about 30% to about 70% by volume and is at least 90% aliphatic by weight and wherein the step of contacting the surface with the composition

includes spraying the composition upon the surface and wherein the surface is part of a bedliner of an automotive vehicle.”

Claim 22 dependent upon claim 4 now recites, “wherein the at least one primary amine present has a molecular weight greater than about 200 and the at least one secondary has a molecular weight of at least about 190.” The application, in this regard, reads, “Though others can be used, primary amines present is the resin preferably have a molecular weight greater than about 200 (e.g., for reduced volatility), and secondary amines present in the resin are preferably diamines with molecular weights of at least about 190 (e.g., about 210-230).”

Claim 23 dependent upon claim 22 now recites, “wherein the isocyanate component has a residual monomer level that is less than about 1% by weight.” The application, in this regard, reads, “Moreover, It is desirable for the isocyanate to have a relatively low residual monomer level that is preferably less than about 1% by weight, more preferably less than about 0.2% by weight and most preferably less than about 0.05% by weight. Such low residual monomer level can assist in lowering volatile emission levels while handling the unreacted component or during application of the composition.”

The use of the aliphatic isocyanates, as specified, along with the other specifications of claims 22 and 23 form a system of lower toxicity that is suitable for spray applications to an automotive bedliner as recited in claim 4. This is in contrast to the Burton reference, which is directed to applying a material with a trowel. (see col. 7, lines 1-7). Applicants contend that this alone is a basis for patentability and it is a particularly strong basis for patentability when taken in conjunction with the rest of claim 1, which forms a coating with recited desired characteristics.

Claim 2 and new claim 32

Claim 2 now recites, “wherein the isocyanate has a residual monomer level that is less than about 1% by weight.” Such language has been discussed above and Applicants contend that claim 2 provides a spray coating particularly suitable and desirable for a bedliner of an automotive vehicle.

Applicants also draw attention to claim 32 which recites:

- i) the amount of the at least one secondary amine is between about 40% and about 80% by volume of the second component and the at least one primary amine is between about 10% and about 40% of the second component;
- ii) the isocyanate has a residual monomer level that is less than about 1% by weight; and
- iii) the second component includes at least 40% of an aspartic acid ester by weight.

Claim 3

Claim 3 now recites, "wherein upon two weeks of water immersion at 32°C, or exposure to 100 % relative humidity at 38°C, the coating exhibits substantially no blistering, dulling or softening or loss of adhesion, and wherein the coating exhibits substantially no blistering, cracking or charring when sag panel tested for two weeks at about 70°C." Applicants suggest that in view of the above discussion, it should be recognized that no spray coating has been provided for a vehicle with the recited characteristics in conjunction with the other language of claim 3 and/or in conjunction with language of its dependents.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu

Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

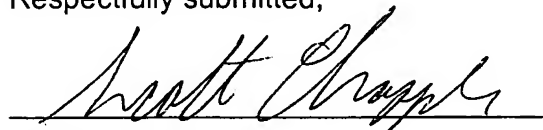
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Respectfully submitted,

Dated: 4 March, 2005



Scott A. Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215